

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 12-17 will have been amended and claim 18 will have been submitted for consideration by the Examiner. In view of the above, Applicants respectfully request reconsideration of the outstanding objection and rejections of the all claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided as well as for the acceptance of the drawings filed in the present application on November 27, 2001.

Turning to the merits of the action, the Examiner has objected to the specification under U.S.C. § 132(a) because it introduces new matter into the disclosure of the invention. By the present invention, Applicants have amended the specification to eliminate a controller included in the server or a controller included in the transmitting IP apparatus. The transmitter and analyzer have clear support in the specification at, inter alia, Fig. 2. Thus, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner has rejected claims 12-17 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. By the present amendment, Applicants have amended claims 12-13 and 15-17 to eliminate a controller included in the server or a controller included the transmitting IP apparatus. Applicants note that the feature of “an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus” is supported by, for example, the

paragraph [0062] of the specification. Thus, Applicants respectfully that the Examiner withdraw the objection.

The Examiner has rejected claim 14 under U.S.C. § 112, second paragraph because of an informality. By the present amendment, Applicants have amended claim 14 to eliminate the informality. Thus, Applicants respectfully request that the Examiner withdraw the rejection.

The Examiner has rejected claims 12, 13, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by AGRAHARAM et al. (U.S. Patent No. 5,987,508). The Examiner also has rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over AGRAHARAM et al. in view of GOODMAN (U.S. Patent No. 6,735,617).

However, Applicants respectfully traverse the above rejections.

As noted above, Applicants have amended claims 12-17 and have submitted claim 18 for consideration by the Examiner. Applicants respectfully traverse the above rejections based on claims 12-18 and will discuss said rejections with respect to the pending claims in the present application as will be set forth herein below. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicants' claims 12-15 and 18 generally relate to a server apparatus connected to a transmitting IP apparatus. The transmitting IP apparatus transmits an e-mail to a receiving IP apparatus via the server apparatus. The server apparatus comprises a memory which stores an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus. The IP address of the receiving IP apparatus is distinct from an e-mail address. The server apparatus comprises a

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receiver which receives, from the transmitting IP apparatus, the e-mail. The e-mail includes the telephone number of the receiving IP apparatus. The server apparatus further comprises an analyzer which obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus. The server apparatus includes a transmitter that transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Claim 16 recites a related system. Claim 17 recites a related method.

In direct contrast, AGRAHARAM et al. relates to a system which includes transmitting client terminal 101, translation server 110, and receiving client terminal 102. When a user of the client terminal 101 wishes to send an e-mail to a recipient of the client terminal 102, the user uses an alias telephone number/e-mail address of the recipient, for example, "2015558765@email.att.net". The number "2015558765" indicates a telephone number of the recipient. The translation server 110 contains a database 117 that stores the telephone number of the recipient, for example, "2015558765" and an actual e-mail address of the recipient associated with the telephone number, for example, "steve2aftmail.com". When the translation server 110 receives an e-mail message addressed to the alias e-mail address "2015558765@email.att.net" from the client terminal 101, the translation server 110 accesses the database 117 using the telephone number "2015558765" included in the alias e-mail address, and retrieves from the database 117, an actual e-mail address "steve2aftmail.com" associated with the telephone number "2015558765". Then, the translation server 110 forwards the e-mail message to the recipient of the client terminal

102, based on the actual e-mail address "steve2aftmail.com" (col. 3, lines 10-66). In other words, AGRAHARAM et al. relates to an address translation between the alias e-mail address "2015558765@email.att.net" and the actual e-mail address "steve2aftmail.com" (col. 3, lines 24-28).

However, AGRAHARAM et al. does not disclose a server apparatus that stores an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus. Rather, AGRAHARAM et al. discloses the database 117 that stores an actual e-mail address "steve2aftmail.com" and an associated telephone number "2015558765". An IP address is distinct from an e-mail address. For example, Fig. 3 of the present application shows samples of IP addresses, for example, "133.185.250.12" and "133.185.250.13". These are clearly not e-mail addresses.

On the other hand, the present invention recites a memory that stores an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus. The IP address of the receiving IP apparatus is distinct from an e-mail address including an alias e-mail address and an actual e-mail address.

Thus, AGRAHARAM et al. relates to an alias e-mail address and an actual address, the alias e-mail address being associated with a recipient's telephone number. However, and in direct contrast to the above, Applicants claims relate not to an e-mail address at all but to a telephone number and an IP address of the receiving IP apparatus. The teachings of AGRAHARAM et al. related to an e-mail address clearly do not teach storing of an IP address as recited in Applicants claims.

By the present Response, Applicants have amended claim 12 to explicitly recite that the IP address is distinct from the e-mail address. This is inherent in the nature of

these two addresses and Applicants amendment of the claim to recite this feature merely explicitly recites that which is inherently true. In other words, the IP address is different and distinct from an e-mail address.

Thus, the pending claims are clearly distinguished over AGRAHARAM et al.

Thus, since AGRAHARAM et al. does not comply with the recitations of the pending claims, the pending claims are clearly distinguished over AGRAHARAM et al.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 12-18 are not disclosed in AGRAHARAM et al. cited by the Examiner.

Regarding the rejection of claim 14 under U.S.C. § 103(a), GOODMAN relates to a system in which, when the sender's computer 920 sends a facsimile message to the recipient's facsimile machine 975, and the facsimile message is sent from the sender's computer 920 to the sender's mail server 930. An address of the recipient's facsimile machine 975 includes a telephone number of the recipient's facsimile machine 975 and a domain name of the facsimile mail server 950. The sender's mail server 930 obtains an IP address of the facsimile mail server 950 from the DNS server 945, based on the domain name of the facsimile mail server 950. The sender's mail server 930 forwards the facsimile message to the facsimile mail server 950, based on the IP address of the facsimile mail server 950. The facsimile mail server 950 selects a gateway to which the facsimile message should be forwarded and forwards the facsimile message to the selected gateway. The gateway is selected, based on loads on different gateways at a time when the facsimile communication is forwarded. Ultimately, the facsimile message is delivered from the selected gateway to the recipient's facsimile machine 975 over a "conventional telephone network" 970 (col. 6, lines 54-67 and col. 7, lines 1-33).

However, in GOODMAN, a telephone number "1112223333" is assigned to recipient's facsimile machine 975 (col. 6, lines 63-67), but an IP address is not assigned to the recipient's facsimile machine 975. The telephone number "1112223333" assigned to the recipient's facsimile machine 975 is a conventional telephone number (col. 6, lines 38-46). In other words, GOODMAN does not contain any disclosure regarding an IP address of the recipient's facsimile machine 975. Thus, in GOODMAN, a facsimile message is forwarded from the VOIP Outbound Gateway 956 to the recipient's facsimile machine 975 over the conventional telephone network 970, using the telephone number "1112223333" of the recipient's facsimile machine 975.

Further, an address, for example, "1112223333@faxservername.xxx" is utilized for forwarding a facsimile message to the recipient's facsimile machine 975. The address consists of the conventional telephone number of the recipient's facsimile machine 975 and a name of the facsimile mail server 950 (col. 6, lines 38-46 and col. 7, line 15). In other words, the address does not include an address of the VOIP Outbound Gateway 956. Thus, GOODMAN does not contain any disclosure regarding a telephone number of the VOIP Outbound Gateway 956.

Thus, GOODMAN does not disclose a H.323 gatekeeper which stores the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since GOODMAN does not contain any disclosure regarding an IP address of the recipient's facsimile machine 975 or a telephone number of the VOIP Outbound Gateway 956. GOODMAN also does not disclose an analyzer which determines whether the memory stores the IP address of the receiving IP apparatus. Further, GOODMAN does not disclose a transmitter which accesses the H.323

gatekeeper to obtain the IP address of the receiving IP apparatus when it is determined that the memory does not store the IP address of the receiving IP apparatus.

Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus.

Thus, GOODMAN does not comply with requirements, recited in claim 14, so this pending claim is clearly distinguished over GOODMAN.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claim 14 are not disclosed in GOODMAN cited by the Examiner. Claim 14 is also submitted to be patentable over the Examiner's proposed combination, since neither of AGRAHARAM et al. and GOODMAN, nor any proper combination thereof, disclose the combination of features recited in Applicants' claim 14.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

In accordance with the provisions of 37 C.F.R. § 1.116, the amendments to the claims presented by the present Response do not raise any new issues requiring further consideration or search. As noted above, the recitation of the IP address being distinct from an e-mail address merely sets forth explicitly what is inherently true regarding the nature of IP and e-mail addresses. The remainder of the amendments to the claims are merely made in order to overcome the Examiner's objections under 35

U.S.C. § 112 as well as to enhance the clarity of the language by making various typographic changes.

Regarding the newly submitted claim, in view of the fact that Applicants have set forth a clear evidentiary basis supporting the patentability of all the claims in the present application, it is respectfully submitted that new claim 18 raises no new issues requiring further consideration or search since it is dependent from a shown to be allowable claim and support for this feature is disclosed at least in SMTP transmission unit 209 of Fig. 2.

Accordingly, entry of the present Response, reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application is respectfully requested in due course.

Although the status of the application is after final rejection, Applicants submit that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues are being presented as it is assumed that the Examiner has searched and considered the claim limitations as they were discussed in the specification.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended the rejected claims and have submitted a new claim for consideration by the Examiner.

With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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Respectfully submitted,
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